

**REMARKS/ARGUMENTS**

Upon entry of this amendment, claims 2-8 and 10-17 will be canceled without prejudice or disclaimer of the subject matter recited therein, claims 1 and 9 will be amended, and claims 18-40 will be added, whereby claims 1, 9 and 18-40 will be pending. Claims 1, 9, 18, 25 and 32 are independent claims.

By the amendment herein, claims 1 and 9 have been amended to clarify their recitations and claims 39 and 40 have been added to be dependent upon claim 9. Moreover, claims 18-38 have been added directed to methods associated with Applicants' invention. Support for claims 18-38 appear throughout Applicants' originally filed application, including the first three paragraphs of page 5. Moreover, the specification has been amended to explicitly include the subject matter of the method claims.

Reconsideration and allowance of the application are respectfully requested.

**Consideration Of Information Disclosure Statements**

Applicants express appreciation for the inclusion with the Office Action of a copy of the initialed Form PTO-1449, whereby the Examiner's consideration of the Information Disclosure Statement, filed September 12, 2002 is of record.

**Additionally, further to telephone conversations with the Examiner on April 1 and 2, 2004, the Examiner is reminded that a Supplemental Information Disclosure Statement was filed by facsimile and in the mailroom on April 2, 2004. The Examiner is respectfully requested to confirm consideration of this Supplemental Information Disclosure Statement by**

**forwarding an initialed copy of the Form PTO-1449 submitted therewith with the next communication from the Patent and Trademark Office.**

**Still further, Applicants note that the Examiner has cited JP 409094065 and JP 05255097 in the lack of unity requirement mailed November 4, 2003, but has only listed one of these documents, i.e., JP 05255097, on the Form PTO-1449 attached to the present Office Action. Applicants note that upon review of the papers attached to the Office Action, JP 409094065 is included therein. Accordingly, in order that the record reflects the Examiner's consideration of this document on the face of the issued patent, Applicants are enclosing a Form PTO-1449 listing JP 409094065. The Examiner is requested to forward an initialed copy of this form with the next communication from the Patent and Trademark Office.**

Applicants submit that no fee should be necessary. However, if any fee is necessary, Applicants authorize that Deposit Account No. 19-0089 be charged any required fee.

### **Claim Of Priority**

The Office Action acknowledges the claim of foreign priority as well as receipt of the certified copy of the priority application in this national stage application.

### **Formal Drawings**

Applicants note that the Office Action does not object to the drawings. Applicants therefore assume that the drawings submitted with the application are considered to meet all

requirements, and no further action is required on the part of the Applicants with respect to submission of formal drawings.

### **Response To Maintaining Of Lack of Unity Requirement**

Applicants note that the lack of unity assertion should be withdrawn because it is supported by JP 409094065 and JP 05255097 which documents are not utilized in a rejection in the present Office Action.

Still further, Applicants remind the Examiner that the criteria set forth in 37 C.F.R.1.475 must be applied when making a lack of unity requirement. In this regard, it is noted that 37 C.F.R. 1.475(b) indicates that an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories, with one of the categories being a product and process of use of said product.

Therefore, unity of invention is present and the requirement should be withdrawn.

### **Response To Obviousness-Type Double Patenting Rejection And Rejection As Being Anticipated By Naganushi et al., JP Abstract 10130153 A**

Claims 1-3, 5-8, 10, 11 and 13-17 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over the claims of co-pending Application Nos. 10/466,541; 10/451,786; 10/070,434; 10/181,421; 10/070,435; and 10/451,787.

Moreover, claims 1-3, 5-8, 10-11, 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Naganushi et al., JP Abstract 10130153 A. In this ground of rejection the Examiner asserts that Naganushi et al. discloses an agent comprising the same agent as recited in Applicants' claims and produced in the same manner.

In these grounds of rejection, it is asserted that the preamble does not generally give weight where it merely recites the purpose of a process or an intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. Therefore, the rejections assertion that the claims are obvious over the claims of the co-pending applications or are anticipated by Naganushi.

In response, Applicants respectfully submit that claim 1 is directed to an appetite suppressing agent composition which comprises, as an active ingredient, a mixture of cyclic and/or straight chain poly lactic acids having a condensation degree of 3 to 19. However, the applications cited in the obviousness-type double rejection do not recite appetite suppression, and Naganushi does not teach or suggest appetite suppression. Although the intended use of the claimed composition is recited in the preamble of claim 1, the preamble in this case gives life, meaning and vitality to claim 1. In particular, the composition is formulated for appetite suppression and the body of the claim includes such ingredients that relate to the preamble of the claim. Accordingly, the rejections should be withdrawn.

Applicants further note that these same arguments apply to the food or drink compositions of claims 9, 39 and 40. Moreover, claims 18-38 are directed to methods, and the rejections of record should not apply to these method claims. Thus, independent claim 18 and

the claims directly or indirectly dependent therefrom are directed to a method of suppressing appetite in a mammal, comprising administering to a mammal an appetite suppressing effective amount of an appetite suppressing composition which comprises, as an active ingredient, a mixture of cyclic and/or straight chain poly lactic acids having a condensation degree of 3 to 19. Moreover, independent claim 25 and the claims directly or indirectly dependent therefrom are directed to a method of promoting basal metabolism in a mammal, comprising administering to the mammal a basal metabolism promoting effective amount of a basal metabolism promoting composition which comprises, as an active ingredient, a mixture of cyclic and/or straight chain poly lactic acids having a condensation degree of 3 to 19. Still further, independent claim 32 and the claims directly or indirectly dependent therefrom are directed to a method of suppression of excessive appetite or improving obesity in a mammal, comprising administering to the mammal an effective amount of a composition which comprises, as an active ingredient, a mixture of cyclic and/or straight chain poly lactic acids having a condensation degree of 3 to 19 to suppress excessive appetite or improve obesity.

Accordingly, the rejections of record should be withdrawn.

#### **Response To Rejection Under 35 U.S.C. 112, First Paragraph**

Claims 3, 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, because the Examiner asserts that the specification while being enabling for improving obesity does not reasonably provide enablement for preventing obesity. In this ground of rejection, the Examiner asserts that the prior art teaches lactic acid as an agent that is known for treating obesity. However, the Examiner contends

that the prior art does not teach an agent for preventing obesity. The Examiner also asserts that the specification shows treatment and improvement of obesity but the examples do not show preventing obesity. The rejection also asserts that the reduction of obesity indicates that obesity is decreased but not prevented.

In response and without expressing agreement or acquiescence with the rejection of record, Applicants have amended the claims to recite “suppression of excessive appetite” instead of “prevention of obesity” Accordingly, this ground of rejection is no longer applicable, and should be withdrawn.

### **CONCLUSION**

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

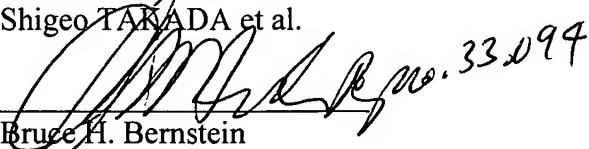
Applicant therefore respectfully requests that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

P22165.A04

Application No. 10/088,523

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Shigeo TAKADA et al.

  
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Form PTO-1449	U.S. Department of Commerce Patent and Trademark Office	Atty. Docket No. P22165	Serial No. 10/088,523
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use several sheets if necessary)		Applicant Shigeo TAKADA et al.	
		Filing Date September 15, 2002	Group 1761

**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	2003	/ 0 0 8 3 3 6 8	05/01/03	MURAYAMA et al.			
	2003	/ 0 0 7 2 7 3 5	04/17/03	MURAYAMA et al.			

**FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
		1 2 1 3 0 2 1	06/12/02	E.P.O.			
		1 2 1 9 6 1 6	07/03/02	E.P.O.			
		1 2 1 9 6 1 7	07/03/02	E.P.O.			
	0	1 / 2 1 1 8 2	03/29/01	W.I.P.O.			
		1 2 2 4 9 3 6	07/24/02	E.P.O.			
	0	1 / 5 4 7 0 5	08/02/01	W.I.P.O.			
	0	1 / 3 9 7 8 2	06/07/01	W.I.P.O.			
	02	/ 0 5 5 0 9 1	07/18/02	W.I.P.O.			
		1 3 5 8 8 8 5	11/05/03	E.P.O.			
	02	/ 0 5 5 0 9 0	07/18/02	W.I.P.O.			
		1 3 5 8 8 8 4	11/05/03	E.P.O.			
	02	/ 0 6 0 4 5 7	08/08/02	W.I.P.O.			
		1 3 6 2 5 9 4	11/19/03	E.P.O.			
	02	/ 0 7 2 5 3 1	09/19/02	W.I.P.O.			
		1 3 7 8 5 0 2	01/07/04	E.P.O.			
	02	/ 0 7 4 8 3 5	09/26/02	W.I.P.O.			

COPY

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**


EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



